UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,843	05/01/2001	Noboru Ogino	01269-LH	7322

1933 7590 01/23/2007

FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
220 Fifth Avenue
16TH Floor
NEW YORK, NY 10001-7708

EXAMINER	
THOMPSON, JAMES A	
ART UNIT	PAPER NUMBER
2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/847,843	OGINO, NOBORU	
	Examiner	Art Unit	
	James A. Thompson	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 October 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *4-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *4-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 27 October 2006 has been entered.

Response to Arguments

2. Applicant's arguments filed 27 October 2006 have been fully considered but they are not persuasive. Firstly, Examiner appreciates Applicant's discussion of the differences between Hisatake (US Patent 5,669,040) and the present independent claims, including the discussion with regard to the designation of the document size. Examiner agrees that the present amendments to the claims overcome the prior art references cited in the previous office action, mailed 14 June 2006. However, additional prior art has been discovered which renders the present claims obvious to one of ordinary skill in the art at the time of the invention. Thus, new prior art rejections are set forth below. Examiner also wishes to respectfully point out the rejection under 35 USC §112, 2nd paragraph which is set forth below and in said previous office action, but was not addressed in Applicant's latest response filed 27 October 2006.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 further limits aspects of an apparatus. Claim 13 does not further limit a method, which is what is recited in claim 12, upon which claim 13 depends. Is Applicant reciting a method or an apparatus? Since claim 13 depends from claim 12, claim 13 should recite further limitations of a method. However, based on the body of claim 13, claim 13 appears to recite further limitations of an apparatus instead of further limiting a method claim. Therefore, the recitation of claim 13 is inconsistent and

Applicant has thus failed to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. **Claims 4-5, 7-9, 11-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisatake (US Patent 5,669,040) in view of Yu (US Patent 6,313,928).**

Regarding claims 4, 8 and 12: Hisatake discloses a document reading device (figure 2; figure 18; figure 19; and column 19, lines 42-50 of Hisatake) comprising a document table (figure 18(M4) of Hisatake) which supports a document placed thereon (column 19, lines 62-65 of Hisatake); a cover (shown in figure 18 of Hisatake) which covers the document on said document table, and is configured to be opened and closed with respect to said document table (column 20, lines 4-6 of Hisatake); a document feeder (figure 18(M2) of Hisatake) which feeds a document other than the document on said document table (column 20, lines 4-12 of Hisatake); a document reader (figure 18(M5) of Hisatake) which reads an image of the document placed on said document table or fed by said document feeder (column 20, lines 13-26 of Hisatake); a user interface (figure 8; figure 19(53); and column 21, lines 50-53 of Hisatake) which designates a document size for the document to be output, which is magnified at 100% and is thus the same as the document read by said document reader (figure 8(Sheet); column 12, lines 61-64; and column 13, lines 1-7 of Hisatake); and a controller (figure 19(52) and column 21, lines 50-56 of Hisatake) which specifies a read size corresponding to the document size designated by said user interface (column 12, lines 61-64 and column 13, lines 1-7 of Hisatake) and which controls said document reader to read the image of the document in the read size (column 21, lines 50-56 of Hisatake); said controller being configured to store the document size designated for a document placed on said document table in a state where said cover is closed (figure 8 and column 12, lines 54-64 of Hisatake), and to refer to the stored document size as the read size of the document placed on the document table even when the reading of the document on said document table is interrupted by reading an image of a document fed by said document feeder (column 12, lines 61-64 of Hisatake). The printing for the multiple pages of a print job

is set beforehand, stored and used for the overall printing of the print job (column 12, lines 61-64 of Hisatake). Thus, the interruption that naturally occurs when a new document page is fed by the document feeder does not cause a change in the preset document size.

Hisatake does not disclose expressly that said user interface specifically designates a document size for the document to be read by said document reader: and that said interruption is performed so as to prevent an image from being read in a wrong read size when automatic detection of the size of a document on a document table fails.

Yu discloses designating a document size for the document to be read by the document reader (column 3, line 61 to column 4, line 8 of Yu); and preventing an image from being read in a wrong size when automatic detection of the size of the document on a document table fails by referring to the stored document size (A4) (column 4, lines 9-28 of Yu).

Hisatake and Yu are combinable because they are from the same field of endeavor, namely the control of document properties in a document copying system. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the stored document size (A4) during the reading of a plurality of different document sizes, particularly document sizes that are smaller than the smallest detectable document size, which is A4 in the example cited in Yu. The motivation for doing so would have been to be able to continue reading and transmitting documents without requiring an inordinate and overly costly number of document size detectors (column 1, lines 58-67 of Yu). Therefore, it would have been obvious to combine Yu with Hisatake to obtain the invention as specified in claims 4, 8 and 12.

Further regarding claim 8: The various means recited in the device of claim 8 correspond to the respective portions of the device of claim 4.

Further regarding claim 12: The method of claim 12 is performed by the device of claim 4.

Regarding claims 5, 9 and 13: Hisatake discloses a document size detector (figure 2(13) of Hisatake) which detects a size of the document on said document table (column 6, lines 35-40 of Hisatake), wherein said user interface is configured to designate the document size when said document size detector fails to detect the size of the document on said document table (figure 8; column 12, lines 61-64; and column 13, lines 1-7 of Hisatake). The parameter listing for each job includes information such as the document size (figure 8 and column 12, lines 61-64 of Hisatake). Furthermore, the user interface can be used to specify the document size (column 13, lines 1-7 of Hisatake). Clearly, a document size is required in order for a print job to be executed. Also, the document size *may* be detected by said document size detector, but it also may not be detected, which is evidenced by the passage "*If it*

automatically detects the original document size, information indicating the original document size (job information, a part of function identifier) is output" (column 6, lines 37-40 of Hisatake) [emphasis added].

Regarding claims 7, 11 and 15: Hisatake discloses that said controller includes a memory which separately stores the document size designated for the document on said document table and the document size designated for the document fed by said document feeder (column 12, lines 54-64 of Hisatake). In order for the controller to be able to store, display and allow changes (via the user interface) of the print job, some form of memory is inherent.

7. **Claims 6, 10 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hisatake (US Patent 5,669,040) in view of Yu (US Patent 6,313,928) and Sogame (US Patent 4,673,282).**

Regarding claims 6, 10 and 14: Since the print jobs are performed for the normal operation of the system of Hisatake, it would be reasonable to assume that said controller is configured such that the document size designated for the document on said document table is cleared when said cover is opened. However, Hisatake in view of Yu does not disclose expressly that said controller is configured such that the document size designated for the document on said document table is cleared when the cover is opened.

Sogame discloses that a controller is configured such that the document size designated for the document on said document table is cleared when said cover is opened (column 6, lines 5-13 of Sogame). The size detection only functions when the cover is closed (column 6, lines 5-13 of Sogame). Thus, the document size designated for the document on said document table is cleared when the cover is opened.

Hisatake in view of Yu is combinable with Sogame because they are from the same field of endeavor, namely document size and document attribute detection and setting for digital copiers. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to clear the stored value for document size when the cover is opened, as taught by Sogame. The suggestion for doing so would have been that, with the cover open, outside light will interfere with the detection of the document size. Thus, document size detection will either be impossible or highly inaccurate. Therefore, it would have been obvious to combine Sogame with Hisatake in view of Yu to obtain the invention as specified in claims 6, 10 and 14.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James A. Thompson
Examiner
Technology Division 2625

16 January 2007

DAVID MOORE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600